

## REMARKS

The issues outstanding in the Office Action mailed December 2, 2003, are the requirement for election/restriction, and the rejections under 35 U.S.C §§112, 102 and 103. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

### Requirement for Election/Restriction

It is respectfully submitted that the withdrawn claims, for example, claims 24 and 25, among others, should not be withdrawn from active prosecution at this point. These claims, drawn to various articles produced from the coating composition of the elected claims, are related to the elected claims as combination to subcombination. The claims are related in this manner as the subject matter of claims 24 and 25 *requires* all of the elements of the composition claims, as a result of their dependency thereon. In such a situation, two-way distinctness "must" be shown, see M.P.E.P. §803. In other words, in order to support a restriction requirement, it must be shown that the combination claims, for example claims 24 and 25, can be used apart from the composition of claim 1. In view of their dependency, obviously, this group of claims *cannot* be lacking the elements of the subcombination of claim 1. Thus, two-way distinctness cannot be shown and the restriction requirement should be withdrawn.

Moreover, it is submitted that, once allowable subject matter is found with respect to the elected species the examination in search of the claims *must* be continued to include non-elected subject matter. See M.P.E.P. §§706.03(y) and 803.

### Rejections Under 35 U.S.C §112

Claims 1-5, 9-16, 18-23, 26-34 and 40-47 have been rejected under 35 U.S.C §112, second paragraph. Reconsideration of this rejection is respectfully requested.

With respect to distinction between the semi-crystalline polyamide (A) containing partial amorphous character, and the amorphous polyamide (B), the Examiner's difficulty is not fully understood. The present specification amply and clearly defines these two materials; moreover, the specification discusses the distinction between (A) and (B) at page 7, in the first two paragraphs. It is seen that one of ordinary skill in the art would have no difficulty determining

the difference between a partially amorphous semi-crystalline polyamide and an amorphous polyamide. Moreover, the definitions are used in accordance with their common acceptance in the art, see lines 10 -15 of page 7 of the specification. Withdrawal of this portion of the rejection is therefore respectfully requested.

With respect to component (A) reading on (D), this portion of the rejection has been obviated by the foregoing clarification of component (D) in the above amendment. However, it is important to note that the components of a Markush group, in this case, for example, the polyamides (A), (B), and components (C) and (D), need *not* be mutually exclusive. Any requirement of mutual exclusivity of the members of a Markush group has long since been discarded. See, for example, M.P.E.P. §2173.05(h). In any event, it is submitted that this portion of the rejection is moot.

With respect to the use of the "optional" monomers in the claim, it is not seen that this renders the claim indefinite. The use of "optional" language in a claim has been sanctioned by the Board of Appeals, see *Ex parte Cordova*, 10 U.S.P.Q.2d 1949 (B.P.A.I. 1989) and *Ex parte Wu*, 10 U.S.P.Q.2d 2031 (B.P.A.I. 1989).

Finally, with respect to the notation "PA", it is submitted that such notation is used in the art as a conventional abbreviation for *polyamide*, and would be readily understood by one of ordinary skill in the art. Thus, the term is in no way indefinite. Finally, the "catalyzed" polyamide is amply defined in the present specification at page 19, the second paragraph. Of course, Applicants can define terms in the specification, and then use such shorthand terms in the claims, without such terms being indefinite. It is submitted that the phrase thus fully satisfies the requirements of the statute. With respect to the remainder of the issues at page 3 of the Office Action, minor clarifying changes have been made to the claims, and it is submitted that they fully satisfy the requirements of the statute.

In conclusion, it is submitted that the claims fully satisfy 35 U.S.C §112, second paragraph, and withdrawal of the rejection is respectfully requested.

#### Rejections Under 35 U.S.C §102/103

Various combinations of claims have been rejected under 35 U.S.C §102(b) or under

§103 over EP'001 ("Epstein"), and over Schmid '799. Reconsideration of each of these rejections is respectfully requested.

Epstein discloses the combination of a semi-crystalline polyamide and an amorphous copolyamide, used to produce transparent molded articles. Epstein indicates that certain semi-crystalline polyamides are not compatible with other amorphous copolyamides, thus implying that certain semi-crystalline polyamides *are* compatible. However, the Office Action relies on this disclosure, at page 4, for the argument that the semi-crystalline polyamides themselves, where compatible, must act as a compatibility agent. It is respectfully submitted that this logic strains the meaning of "compatibility agent" beyond reason. However, one can suppose that, if (A) and (B) are compatible in each other, there is *no* compatibility agent present, or needed. Indeed, Epstein teaches, at page 7, lines 11-17, that even where the components are incompatible, the resultant composition can still be molded and used although articles produced therefrom would then not be transparent. Thus, it is not understood how it can be supposed that the components can double as a compatibility agent when Epstein, in fact, teaches that compatibility is not required.

In any event, clarification of compatibility agent (D) in the present claims clearly highlights that Epstein does not, and cannot, disclose or suggest the presently claimed composition, inasmuch as the claimed component (D) is neither disclosed nor encompassed within Epstein.

Similarly, Schmid fails to disclose compatibility agents within the scope of the present claims. For example, patentees disclose, as compatibility agents in column 7 and 8, ethylene-propylene copolymers grafted with maleic acid anhydrides, or butyl-acrylate methylmethacrylate polymers grafted with maleic acid anhydride. Patentees moreover indicate, at column 4, lines 34+, that compatibility agents are materials which are reactive with end groups of the two polyamide components, such as oligomeric and/or polymeric compounds having reactive groups such as acid anhydride carboxylic acids, diacrylic acids, epoxies, amino and/or carboxylic acid group containing materials, etc. Patentees thus clearly fail to disclose or suggest the presently claimed component (D).

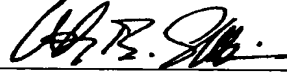
Thus, withdrawal of all the rejections under 35 U.S.C §102 and 103 is appropriate, and is

respectfully requested.

The claims of the application are submitted to be in condition for allowance. However, if the Examiner has any questions or comments, she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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